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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,479	04/19/2004	Hyungsoo Choi	22010-209	3302

7590 11/15/2007
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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,479	Applicant(s) CHOI, HYUNGSOO	
	Examiner Marc S. Zimmer	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 74-77 is/are pending in the application.
- 4a) Of the above claim(s) 74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

The Examiner has considered Applicant's arguments concerning the propriety of the rejection under 35 U.S.C 112, second paragraph. While not in full agreement with Applicant's analysis, it is at least acknowledged that perhaps a rejection under 35 U.S.C. 112, first paragraph may have been more sensible. The rejection under 35 U.S.C. 112, second paragraph is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 76 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the provision of a metal powder by thermally degrading a metal complex precursor, does not reasonably provide enablement for producing the powder from said precursor by any other approach. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

It is significant that, whereas claim 76 is vague as to what precisely follows introduction of the metal complex precursor into the "medium" that leads to powder formation, claim 77 states that the medium is maintained at a temperature above or equal to the decomposition temperature, the implication being that, once injected into the medium, the precursor degrades into the product of interest. Insofar as claim 77 is supposed to be further limiting of claim 76, this would seem to indicate that claim 76, in Applicant's estimation, may embrace other strategies of making the powder, ones

involving the same metal precursor and medium, besides thermal degradation.

Otherwise, there would be no reason to mention/imply thermal degradation as a further limitation of the invention disclosed in claim 76. However, a review of the Specification verifies that there is no alternative approach contemplated for preparing the powder using the aforementioned precursors other than to degrade them in a high temperature medium. Therefore, the Examiner submits that claim 76 is claimed more broadly than what is supported by the Specification.

In truth, whether the Examiner rejects claim 76 using the rational set forth herein or under second paragraph of the statute, as had been done previously, the rejections represent nothing more than a means to an end. Simply put, the Examiner believes that claim 76 is not sufficiently forthcoming as to what precisely leads to the formation of the powder product. If the so-called "medium" were just an inert gas such as argon held at ambient temperature, then the complexes would not be converted into the powder sought. Indeed, it is only through thermal degradation of the complexes that the claimed powder is realized and this fact is not articulated by claim 76, which is why the Examiner had earlier asserted that claim 76 was lacking the "essential element" of a medium maintained at a temperature at or above the thermal decomposition temperature of the complex.

Claims 74 and 75 remain in the status of being directed to an invention non-elected without traverse.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 12, 2007



MARC S. ZIMMER
PRIMARY EXAMINER